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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/475,653	12/30/1999	RONALD M. SMITH	42390.P6384	6654

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JAMES M WU  
BLAKELY SOKOLOFF TAYLOR & ZAFMAN  
12400 WILSHIRE BOULEVARD  
SEVENTH FLOOR  
LOS ANGELES, CA 90025

EXAMINER

ROBINSON, GRETA LEE

ART UNIT PAPER NUMBER

2168

DATE MAILED: 04/13/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/475,653

Applicant(s)

SMITH ET AL.

Examiner

Greta L. Robinson

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 30 January 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1, 2, 6, 8, 11, 12, 15, 16 and 27-33 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 2, 6, 8, 11, 12, 15, 16, and 27-33 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on January 30, 2006 has been entered.

2. Claims 1, 2, 6, 8, 11, 12, 15, 16, and 27-33 are pending in the present application.

3. Claims 3-5, 7, 9-10, 13-14 and 17-26 have been cancelled. Claims 1, 2, 6, 8, 11, 12, 15, 16 and 27 have been amended; and new claims 28-33 have been added.

### ***Claim Rejections - 35 USC § 112***

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 1, 2, 6, 8, 11, 15, 16 and 27-33 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding independent claims 1, 8 and 15 the limitation "predetermined criterion" and "criteria" are vague [see: claim 1 line 3 and 5; claim 8 lines 5 and 9; and claim 15 lines 9 and 11]. It is unclear as to what Applicant is referring to with respect to the limitation predetermined criteria or criteria. The disclosure describes a "notification criteria" see Figure 3 element (304) and page 14 lines 8-18. The notification criteria appears to be a structure that contains at least the sender's name, subject line, number of bytes, time of arrival, size of message and numerical number as shown in Figure 3 elements 310 through 320 and described on page 14 of the disclosure. For clarity and consistency of terms the examiner suggests the limitation "notification criteria" as opposed to predetermined.

Claims 1, 2, 6, 8, 11, 12, 15, 16, and 27-33 rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential elements, such omission amounting to a gap between the elements. See MPEP § 2172.01. The omitted elements are: "number of bytes" and "numerical number" [see Figure 3 elements 314 and 320; page 14 last to full paragraphs]. Note Applicant appears to add a limitation regarding the structure of the notification criteria (i.e. predetermined criteria); but the disclosure appears to describe it as containing all of the features as depicted in Figure 3 elements 304, 310, 312, 314, 316, 318 and 320.

### ***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1, 2, 6, 8, 11, 12, 15, 16, and 27-33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Miller et al. US Patent 6,421,707 B1 in view of Austin US Patent 6,157,924.

Regarding Claims 1, 8 and 15, Miller teaches:

in response to receiving a new email, determining, according to a user profile, if the new email matches a predetermined criterion of when to send notice of a new email to a cellular phone ... (Figure 1, Element 135 and corresponding text; see also Col 4, Lines 21-23; see also Col 2, Lines 65-67 through Col 3, Lines 1-5; see also Figure 3, Element No. 395 and corresponding text; see also Figure No's 4a-c and corresponding text; see also Col 4, Lines 40-60, specifically Lines 49-52, i.e. when; see also Figure No. 4(f), Element No. 412 and corresponding text);

wherein a content of the notice is customized (please see Figures 6f – 6i and corresponding text; see also Col 7, Line 39 through Col 8, Line 30);

if the cellular phone uses GSM (Figure 3 and corresponding text, see also Figure 8 and corresponding text; see also Col 9, Lines 55-58) sending the customized notice of the new email via SMS (Figure No. 8, Element No. 721, and corresponding text);

sending the customized notice of the new email via SMTP (Figure No. 7, Element No. 711, and corresponding text); and

memory and processor (Col 3, Lines 53-65).

Miller reference discloses all of the claimed subject matter set forth above, except it does not explicitly indicate the step of generating a noticed of the new email... per the user profile database. However, Miller teaches delivery format and how one of them is more appropriate than the other and how the user may select one based on a preference (Abstract, i.e. *The subscriber*

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is then notified by the network of the message (delivery mechanism) and then delivers the message and any multimedia attachments to the message to the subscriber, according to a delivery indication sent by the subscriber (according to the user profile) to the network; see also Col 4, Lines 51-60; see also Col 3, Lines 33-38; see also Col 5, Lines 8-12, i.e. providing a number of data services; see also Col 4, Lines 49-51; see also Col 2, Lines 58-64, i.e. Delivery system 160 includes interfaces to a variety of delivery systems; see also Col 3, Lines 16-19, i.e. Converter bank subsystem 180 converts an input into an appropriate delivery format prior to its delivery to the subscriber. The delivery format is advantageously specified by the subscriber. However, Austin teaches generating a noticed of the new email... per the user profile database (Abstract; see also Figure No. 3, i.e. Element No. 80a and 80b; see also Figure 4 and corresponding text; see also Figure 4C, Element No. 58C and corresponding text.

Given the intended broad application of the Miller system, it would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to Modify the teachings of Miller with the teachings of Austin to generate a customized noticed of the new email per the user profile database to increase the flexibility of the system by reaching a larger user community, especially when the user is able to specify more then one type of a delivery for the email in his/her profile.

Regarding Claims 2, 11 and 16, Miller teaches receiving the user profile (Figure 4c; see also Col 4, Lines 41-51; see also Figure 11).

Regarding Claims 6, 12 and 27, Miller teaches secure manner (Figure 4a – 4b;

i.e. the security option on the top tool bar).

The limitations of claims 28-33 have been addressed above in independent claims 1, 8 and 15 except for a delivery mechanism includes sending the customized notice. Note Miller et al. teaches selective transmission of the message through various protocols [see: Figure 2 (233) selective retrieval; Figure 3, Figure 4c; Figure 8 SMS, SMPT, cellular telephone and Internet connection; Figure 11; col. 3 lines 52-65; col. 4 lines 61-67; col. 5 lines 58-59col. 7 lines 58-60col. 9 lines 33-37].

### ***Response to Arguments***

8. Applicant's arguments filed January 6, 2006 have been fully considered but they are not persuasive.

In the response Applicant argues the prior art does not teach the amended feature "the predetermined criterion includes one or more of a sender's name, subject line, a size, and a time of arrival".

In response to Applicant's argument the examiner respectfully maintains the rejection. Miller et al. teaches upon receipt of the message, the network determines an appropriate action to take with respect to the message based upon a profile of the subscriber [abstract]. The message is delivered according to a delivery indication that may be customized [see: abstract; Figure 1 *user profiles* (135); Figure 4c *user agent email customization*, 410 rules; col. 2 line 65 through col. 3 line5 *consults profile database with respect to filtering*; col. 4 lines 40-61 *ability to customize receipt of message by defining a set of rules*; col. 5 lines 1-14 *predetermined rule based criteria for notification*; col. 5 lines 41-59 *transmitting the reply is customizable SMS advantageous; multiple formats for delivery* col. 7 lines 59-62; also col. 9 lines 20-58].

Applicant's arguments with respect to claims 1, 2, 6, 8, 11, 12, 15, 16, and 27-33 have been considered but are moot in view of the new ground(s) of rejection.


### ***Conclusion***

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9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Greta L. Robinson whose telephone number is (571)272-4118. The examiner can normally be reached on M-F 9:30AM-6:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tim T. Vo can be reached on (571)272-3642. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



GRETAL ROBINSON  
PRIMARY EXAMINER

Greta Robinson  
Primary Examiner  
April 7, 2006